

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

DESJARLAIS et al.

Application No. 10/820,466

Filed: 03/31/2004

For: *Methods for Rational Pegylation of
Proteins*

Examiner: LIN, Jerry

Art Unit: 1631

Conf. No.: 7266

CERTIFICATE OF ELECTRONIC TRANSMISSION
UNDER 37 C.F.R. 1.6(a)(4)

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Dated: October 2, 2007

Signed: /

Victoria Poulsen

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 CFR 1.181(a)**

Mail Stop Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants hereby submit a Petition to Withdraw Holding of Abandonment under 35 CFR 1.181(a). As provided by MPEP 711.03(c)(I), Applicants believe that no fee is due.

Statement of Facts

1. On July 1, 2005, Applicants filed a change of address associated with customer number 32940. The Request for Customer Number Data Change, enclosed herewith as Exhibit A, shows that at least as of July 1, 2005, Applicants were to receive all further correspondence at 555 California Street.

2. In July of 2005, Applicants filed a change of address with the United States Postal Service.

3. Roughly a year later, presumably sometime in July of 2006, the United States Postal Service discontinued the forwarding of mail to Applicants' new address at 555 California Street, in accordance with Postal Service procedures.

4. On September 13, 2006, the Office mailed a Requirement for Restriction/Election to Applicants' previous address at Four Embarcadero Center.

5. On September 25, 2006, the Office received the Requirement for Restriction/Election, which was returned to the Office as undeliverable.

6. On December 1, 2006, attorneys for Applicants moved to a new law firm.

7. On March 13, 2007, the six month statutory period for submitting a response to the Requirement for Restriction/Election lapsed. Applicants did not submit a response to the Requirement for Restriction/Election within this period.

8. On April 12, 2007, a Notice of Abandonment was mailed to Applicants' previous address at Four Embarcadero Center.

9. On April 20, 2007, the Office received the Notice of Abandonment, which was returned to the Office as undeliverable.

10. Applicants never received the Requirement for Restriction/Election mailed September 13, 2006.

11. All Office communications received by Applicants are docketed in Applicants' docketing system.

12. A search of the file jacket and docket records from September 13, 2006, (the date of mailing of the Requirement for Restriction/Election) to April 12, 2007, (the date of mailing of the Notice of Abandonment) indicates that the Requirement for Restriction/Election was not received.

13. Exhibit B enclosed herewith shows Applicants' docket record from September 13, 2006, to December 1, 2006 for the present application.

14. Exhibit C enclosed herewith shows Applicants' docket record from December 1, 2006 to April 12, 2007. Because of the change in law firms, Docket No. 34100/US/2 in Exhibit B corresponds to Docket No. 67461-5118 in Exhibit C. In Exhibit C, a query on Docket No. 67461-5118 would show docket entries for the present case, Application No. 10/820,466. Exhibit C indicates no docket entries during the period spanning December 1, 2006 to April 12, 2007.

15. Exhibit D enclosed herewith shows all of the docket entries for the present application. Entries with respect to the Requirement for Restriction/Election mailed September

13, 2006, were entered, as indicated, on April 19, 2007, which was *after* the date of mailing of the Notice of Abandonment on April 12, 2007.

Non-receipt and non-docketing of the Requirement for Restriction/Election mailed September 13, 2006, is not in dispute.

The file history clearly shows that Applicants did not receive the Requirement for Restriction/Election mailed September 13, 2006. The United States Postal Service returned to the Office both the original Requirement for Restriction/Election mailed September 13, 2006, and the original Notice of Abandonment as undeliverable. In addition, Applicants have attached docket records that indicate that those office communications were never received and docketed. Based on the return to the Office of the original office communications as undeliverable as well as the attached docket records, Applicants do not believe that further documentary evidence is necessary to prove non-receipt of the office communication to which reply was required to avoid abandonment. Applicants note that in light of the Office's efforts "to minimize costs and burdens to the practitioner and the Office" in situations such as this, the attached docket record should be deemed sufficient evidence for the present petition. See 1156 OG 53 (October 25, 1993).

The Office has failed to follow proper procedure in notifying Applicants of actions taken by the Office.

Because of the Office's failure to follow its own procedure for notification set forth in the Manual of Patent Examining Procedure as well as Title 37 of the Code of Federal Regulations, the instant application has been improperly held abandoned.

37 CFR 1.32(a)(5)(i) states that "*Customer Number* means a number that may be used to [d]esignate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number[.]" The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. 37 CFR 1.33(a).

Where multiple addresses are associated with an application, the Office must select the address associated with a Customer Number. *See* 37 CFR 1.33(a) ("If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address."). As the Office will not recognize more than one correspondence address, 37 CFR 1.33(a), any inconsistencies

between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application will generally be resolved in favor of the address of the Customer Number. MPEP 403(I).

The relocation of Applicants' Representatives resulted in the appearance of more than one correspondence address in the file wrapper of the instant application. The rules require that that such inconsistency be resolved in favor of the address of the Customer Number. The procedure for sending correspondence to the address associated with a Customer Number was not followed in the instant application, resulting in nonreceipt of a Requirement for Restriction/Election and a subsequent holding of abandonment. The Office's failure to adhere to the procedure provided in the Code of Federal Regulations and the Manual of Patent Examining Procedure has further resulted in a loss of potential patent term.

Application No. 10/820,466 has not been abandoned and the holding of abandonment must be withdrawn.

Although a Notice of Abandonment has been mailed for the instant application, Applicants contend that the application is not in fact abandoned.

35 USC 132(a) requires that "[w]henver, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof[.]" Failure to prosecute the application within six months of the mailing of an office action results in the application being regarded as abandoned. 35 USC 133. However, the Office is compelled to withdraw the holding of abandonment and to remail any correspondence where Applicants have shown that they have not received the Office communication to which reply is required to avoid abandonment. *See Delgar, Inc. v. Schulyer*, 172 USPQ 513 (D.D.C. 1971); *see also* MPEP 711.03(c)(I).

To establish nonreceipt of an Office communication, the practitioner must state that the Office communication was not received by the practitioner and must attest to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. MPEP 711.03(c)(I)(A). A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. *Id.*

As stated above, the Requirement for Restriction/Election of September 13, 2006, was not received by Applicants. A search of the file jacket and docket records indicates that the Office

communication was not received. Applicants have enclosed a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed. See Exhibits B, C & D.

Having complied with requirements set forth in *Delgar* and MPEP 711.03(c), Applicants have satisfied the showing required to establish that the Requirement for Restriction/Election of September 13, 2006, was never received. Applicants therefore request that the Petition to Withdraw the Holding of Abandonment be granted and that the Office remain the outstanding Requirement for Restriction/Election.

In addition, the Applicants note that any patent issuing from Application No. 10/820,466 is subject to patent term adjustment based on the mistake of the Office. 35 USC 154(b)(1)(A)(ii) provides that if the issue of a patent is delayed due to the failure of the Office to respond to a reply under section 132 within 4 months after the date on which the reply was filed, the term of the patent shall be extended 1 day for each day after such period until the Office has responded. As such, Applicants request that the Patent Term Adjustment calculation include this time period.

The Director is invited to call the undersigned at 415.442.1000. The Director is authorized to charge any additional fees that may be required or to credit any overpayment or refunds to Deposit Account No. 50-0310 (Docket No. 067461-5118-US).

Respectfully submitted,

Dated: 10/2/07
MORGAN, LEWIS & BOCKIUS LLP
One Market, Spear Street Tower
San Francisco, CA 94105
Telephone: 415.442.1000
Facsimile: 415.442.1001
Customer No. 67374


Robin M. Silva, Reg. No. 38,304

EXHIBIT A

07/01/2005 12:46 FAX 415 398 3249

DORSEY & WHITNEY LLP-SF

002/002

PTO/SB/134A (9-05)

Approved for use through 07/01/2008. OMB 051-0038
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☒ Please change Address to:

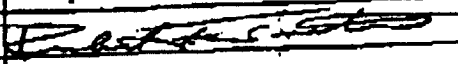
Firm or Individual Name	Dorsey & Whitney LLP				
Address	555 California Street, Suite 1000				
City	San Francisco	State	CA	Zip	94104-1513
Country	USA				
Telephone	(415) 781-1999	Email			

☐ Please delete the following practitioner registration number(s) from the Customer Number indicated above:

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☐ Additional practitioner registration numbers are listed on supplemental sheet(s) attached hereto (PTO/SB/124B or equivalent)

Request Submitted by: (must be a person, e.g. registered practitioner, associated with the customer number shown above)

Firm Name (if applicable)	Dorsey & Whitney LLP		
Signature			
Name of Person Submitting request	Richard F. Trecearlin	Registration No.	31,801
Telephone Number	(415) 781-1999	Date	July 1, 2005

This collection of information is required by 37 CFR 1.55. The information is required to obtain or retain a benefit by the public which is in the (and by the USPTO to process) an application. Confidentiality is provided by 36 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop EBC, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-0198 (1-800-786-0198) and select option.

EXHIBIT B

Patent Record Sheet

Docket ID	34100/US/2	Attorneys	SILVA Robin M., NGUYEN Tuan, PARKER AnnEllice, WORRALL Timothy A.		
Former ID		Office	San Francisco		
Client	Xencor, Inc.	Application No	10/820466		
Client-Matter	463077-00272	Application Date	Mar-31-2004		
Client Ref. No	XEN-P005	Grant No			
Country	United States of America	Grant Date			
Short Title	METHODS FOR RATIONAL PEGYLATION OF PROTEINS	1st Publication No	US-2004-0249576-A1		
		1st Publication Date	Dec-09-2004		
		Expiration Date			
		Priority Date			
Inventors	DESJARLAIS John Rudolf, ZALEVSKY Jonathan		License of Right	<input type="checkbox"/>	Small Entity <input type="checkbox"/>
Convention	Pri. Claimed		Claimed Priorities and Parent Records		
Origin		Relation	Docket ID	Application No	Date
Type	Patent	Base Provisional	34100/US	60/459094	3/31/2003
Sub Type	Non-provisional application		Foreign Assoc.		
Status	Inactive		& Ref. No.		
Sub Status	Transferred		Tax Receiver		

Docket

Action / Event	Reminder	Due	Done/Recorded
Notes			
Check Status on PAIR		Dec-22-2006	
RE-DOCKETED FROM 12/22/2004			
IDS Due		Dec-30-2006	
RE-DOCKETED FROM 6/30/2004			
Priority Claim Due		Jul-31-2004	Jan-01-1850
Application Date			Mar-31-2004
*Notice of Missing Parts Mail Date (See Notes)			Jun-22-2004
Awaiting Filing Receipt		Jun-30-2004	Jun-22-2004
*Notice of Missing Parts - Response Filed			Jul-29-2004
Publ: First			Dec-09-2004

Memo:

***Files have been transferred on 12/12/06 to:
Robin Silva, Esq.
Morgan, Lewis & Bockius LLP
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San Francisco, CA 94105***

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From: 01-Dec-2006 To: 12-Apr-2007

Docket Number: 67461-5118

Client:

Agent:

Country:

US

Area:

Attorney:

Inventor:

Owner:

Location:

Status(es):

Case Type(s):

Status Codes:

- ☐ Active
☐ Inactive
☒ All

EXHIBIT C

EXHIBIT D

Actions Due

Thursday, September 27, 2007

Page: 1

Docket Number: 67461-5118

SubCase:

Ctry Sub:

Country: US United States of America

Case Type: ORD

Status : Published

Filing Date: 31-Mar-2004

Action Type: PA/RR1

Base Date: 13-Sep-2006

Application # : 10/820,466

Response sent date:

Action(s) Due	Due Date	Indicator	Taken
File Election	13-Oct-2006	Due Date	01-Jan-1850
File Election + 1 Mo. EOT	13-Nov-2006	Due Date	01-Jan-1850
File Election + 2 Mo. EOT	13-Dec-2006	Due Date	01-Jan-1850
File Election + 3 Mo. EOT	13-Jan-2007	Due Date	01-Jan-1850
File Election + 4 Mo. EOT	13-Feb-2007	Due Date	01-Jan-1850
File Election + 5 Mo. EOT	13-Mar-2007	Final	01-Jan-1850

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